REMARKS

In the Office Action dated June 17, 2002, the Examiner has set forth a requirement for restriction under 35 U.S.C. §121, alleging that the subject matter defined by the claims of the present invention represents the following two separate and distinct inventions:

I. Claims 26-29 and 37-42 drawn to the cytokine agent and pharmaceutical composition, classified in class 530, subclass 350.

II. Claims 30-36, drawn to the method of inhibiting the proliferation of malignant breast cancer cells in a mammal comprising administering cytokines, classified in class 514, subclass 2.

The Examiner admits that Groups I and II are related as product and process of use. However, the Examiner contends that Groups I and II are distinct inventions because the cytokines of Group I can be used in methods other than those of Group II, e.g., methods for inhibiting or inducing proliferation of cells other than breast cancer cells, and because the process of inhibiting the proliferation of malignant breast cancer cells in a mammal (Group II) can be practice with a product other than those of Group I, e.g., chemotherapy or radiation products. The Examiner further states that Claims 27 and 37 are generic to a plurality of disclosed patentably distinct species of cytokines comprising OSM, IL-6, IL-I 1, LIE and EGF. Applicant is required under 35 U.S.C. §121 to elect a single disclosed species.

In order to be fully responsive to the Examiner's requirement for restriction, Applicants provisionally elect to prosecute the subject matter of Group II, Claims 30-36, directed to a method of inhibiting the proliferation of malignant breast cancer cells in a mammal comprising administering cytokines. In response to the species election, Applicants elect the cytokine species OSM for prosecution.. Applicants reserve the right to file a divisional application directed to the non-elected subject matter in this application.

However, pursuant to 37 C.F.R. §§ 1.111 and 1.143, Applicants hereby traverse the

Examiner's requirement for restriction and request reconsideration thereof in view of the following remarks.

An Examiner's authority to require restriction is defined and limited by statute:

> If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.

35 U.S.C. § 121, first sentence (emphasis added). The implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions which are both independent and distinct, 37 C.F.R. §§1.141-142. Without a showing of independence and distinctness, a restriction requirement is unauthorized.

In the present application, the claims which the Examiner has grouped separately are not "independent and distinct" so as to justify the restriction requirement. Applicants respectfully submit that the methods of Group II merely teach how to make and use the cytokine agents and pharmaceutical compositions of Group I. Therefore, Groups I and II are different aspects of a single invention.

Applicants further submit that the interdependence of Group I and Group II is confirmed – indeed, it is mandated – by virtue of the fact that 35 U.S.C. §112 compels disclosure of all aspects of the invention in the one application which applicants have filed. For example, an application claiming a cytokine agent is required to disclose inter alia how to make and use that cytokine agent. In other words, a description of the means and method for making and using the subject cytokine agent is a mandatory part of the application to the cytokine agent. Indeed, if any of these aspects of a complete disclosure were omitted, the application could be considered defective under §112, first paragraph. Consequently, it is clear that aspects of a given invention, such as a product and its use, are necessarily interdependent, not independent, from each other.

The courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein. The CCPA has observed:

> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973). This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

The Examiner also states that the inventions have acquired a separate status in the art as evidenced by the separate classification and recognized divergent subject matter and would require independent searches. Thus, the Examiner concludes that restriction for examination purposes is proper.

Reliance on the supposed classification of the groups of claims does not establish independence and distinctness. The classification system has no statutory recognition as evidence of whether inventions are independent and distinct. The classification system is instead an aid in finding and searching for patents.

The classification system is also an unreliable basis for requiring restriction between claims to the various aspects of applicants' unitary invention, because the system exhibits considerable overlap in technical definitions. In particular, the definitions of classes and subclasses in the classification system do not prevent the Examiner from basing patentability decisions, as to claims assigned to one group, on patent references found in the classes or subclass(es) with which he associated another group of claims.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed, classifications seem largely to change in response to considerations of administrative convenience, and often in response to

nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patents assigned to different classifications is "independent and distinct" as those terms are used in 35 U.S.C. §121, which fact proves that basing restriction requirements on the classification system is improper.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), applicants are required to conduct simultaneous prosecution, as here, requiring excessive filing costs or to otherwise compromise the term of related patent assets.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that § 121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle GmbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986). In Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), the court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public interest in the legitimacy of issued patents, Applicants respectfully urge the Examiner not to require restriction in cases such as the present application wherein various aspects in a unitary invention are claimed.

Finally, Applicants respectfully submit that a determination to make the pending restriction requirement final must evidence the patentable distinctness of the defined two groups, one from the other, as presented by the Examiner.

In view of the foregoing comments, it is respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,

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